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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,945	04/26/2000	Jonathan Kepecs	18477-000510US	, 3005

20350 7590 05/27/2005

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,945

Applicant(s)

KEPECS, JONATHAN

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/18/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-27 and 37-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-27 and 37-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 31/05, 3/2/05, 9-28-04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This communication is in response to amendment response filed 11/18/2004.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/2005 has been entered.

Response to Amendment

3. Claims 1-17, 19-27, 36-48 are pending. Claims 1-17, 19-27, and 36-48 are pending. Claims 1, 6-7, 9-10, 17, 19, 20, 36, 39, and 46 have been amended per request. New claim 48 has been added.

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Specification

4. The disclosure is objected to because of the following reasons:

The disclosure is also objected to because it does not conform to the following requirement(s):

37 CFR 1.71. Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

5. In regards to the specific requirements outlined above, the specification does not describe completely a specific embodiment in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or

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discovery appertains, or with which it is most nearly connected, to make and use the same. In particular, the specification fails to describe limitation of claimed invention "prolonging the promoting beyond the predetermined time period.." which is "independent of availability of the first item" per independent claims 1. There is no reference in the specification as originally filed regarding the promoting (or prolonging of it) being performed independent of the availability of the item being promoted.

6. Similarly, limitation of claim 36 "detecting using said computer network system that said granting could not be performed by said computer network" and "responsive to said detecting ..recording a price paid.. and granting a rebate of the difference..at said location".

There is no teaching in the specification as originally filed regarding the detecting step and recording and granting action performed in response to the detection.

Note that claims as originally filed which contain this feature were withdrawn from consideration (see paper 6, Restriction filed 5/8/2003).

Claim Rejections - 35 USC § 112 (First)

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 1-17, 19-27, 36-45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Note Further analysis of patentability of the claims no consideration is given to this limitation.

Claim Rejections - 35 USC § 112 (Second)

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 recites limitation "detecting ..that said granting could not be performed by said computer network", while a preceding step, in contradiction, recites a step "granting said

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discount upon purchase of said first selected item". This defect renders the status of the granting of the discount unclear.

Claim 20 is indefinite because function "limiting an audio device.." fails to functionally relate to any other step of the parent claims.

Claim Rejections - 35 USC § 103

11. Claims 1-5, 11-16, 19-27 and 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over PR Newswire article "Caldor Announces Agreement with New York State Attorney General", dated January 11, 1993 (hereafter "Caldor") and further in view of Scroggie.

As per **claim 1** Caldor teaches a method of extending promotional discounts on items for sale to consumers, comprising:

promoting a first selected item with a discount or special price wherein the discount or special price is granted upon purchase of said first selected item by a consumer within a predetermined time period;

(advertised item available at a sale price during a sale period to a customer)

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determining if said consumer has acknowledged said promoting within the predetermined time period;

(the customer wishes to purchase the advertised item at a sale price visits the store in response to the advertised sale price, the determination whether a customer desires to purchase the sale priced item to the store clerk during the sale period is the acknowledgement of the advertisement)

prolonging the promoting beyond the predetermined time period upon determining that said consumer has acknowledged said promoting within the predetermined time period;

(the customer is entitled to a rain check to purchase the advertised item at the sale price for a time beyond the sale period).

The Caldor article fails to teach that the selected first item (i.e. the advertised item offered at a sale price) is promoted to a consumer who is identified by a unique identifier and that the method of promoting is carried out over a computer network.

Scroggie, in the same field of endeavor teaches identifying a consumer by a unique identifier and Scroggie also teaches that the process of promoting items is carried out over a computer network (see abstract and Col. 4 L 42-59, and Figure 1) .

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It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement unique identification for each consumer by an unique identifier would enable a merchants to provide more effective and focused incentive or promotion for a product and further implementing the process over a computer network as disclosed by Scroggie because extending promotional discounts would enable the consumer to conveniently access the promoted products, it would also enable a merchant to offer the promotion to a wider reach of consumers more economically.

Claim 3 is recited well-known features of discounts or special prices are broadly covered under sale price.

Claims 2, 4: Caldor in combination with Scroggie fail to explicitly teach however, Official is notice is taken that offering a free sample and providing points that can be accumulated is old and well known business practice in product sales and marketing. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use these features in the Caldor method because it would appeal a wider spectrum of consumers that it would provide promotions more suitable to consumers and/or products of different characteristics.

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Claim 5: Caldor in combination with Scroggie fail to teach, however, it is asserted that offering promotions via a direct mail to a predetermined consumers is old and well known practice. It would be a merchant's discretion when to commence the predetermined time period.

It would have been obvious to one of ordinary skill in the art of promotion and marketing to implement the Kremer method of distributing promotions on the Internet using world wide web as disclosed by Scroggie because implementation of the method of extending promotional discounts on the Internet (e-mail transmission, web-page, network accessible from a kiosk etc.) would provide customary benefits of wider reach of potential consumers, easy access of the promotion to the consumers and economy offered by electronic distribution of the promotions.

Claims 11-12: identifying said consumer with a limited direct identification (Scroggie, col. 4 L 42+ customer id.), refer to analysis of claim 1 for reasons for combination of Caldor and Abell.

Claims 13-16 have been analyzed as per claims 2-5 respectively.

Claim 19: said promoting comprises posting a notice of said discount or special price ..via a computer network at a

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location selling said first selected item (Scroggie , col. 5 L 63- col. 6 L 11, offer browser).

Claim 21: promoting a second selected item with a discount ..to said identified consumer is interpreted as being inherent to Caldor in view of Abell since a plurality of items may be offered at discount to the selected consumer.

Claim 22: Once the consumer accepts the first offer to purchase the first item, the merchant sends another such offer to the consumer because the merchant recognizes that the consumer is more likely to purchase a second item based on the past purchase. This feature is inherent to Scroggie, which teaches a targeted promotional advertisement (see detailed description).

Claim 23-26: "limited direct identification" and "full direct identification" (refer to Scroggie, discussion related to customer identifying number, col. 4 L 42-59).

Claim 27: inherent to any purchase of item by a consumer.

Claim 37-45: recites limitations, which are customarily practiced in promotions of goods and services. For example, claim 37 recites "first selected item is associated with a plurality of discounts or special prices". This amounts to the

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customer receiving a sale price item in combination with a manufactures coupon discount. Similarly, it is well known to offer discount to those customers who meet specific and predefined criteria such as purchasing history or habits. The examiner asserts that such features are old and well known and takes official notice to that effect. All other claims are similarly analyzed.

Claims 46 and 47: are rejected under 35 USC 103 (a) over Caldor and Scroggie combination as applied to claim 1. For posting notice feature refer to Scroggie (col. 3 L 30-46).

Claim 48. Caldor and Scroggie as combined in claim 19 fail to teach scanning the item at said location by a scanning device.

However, providing scanning devices which display the discount price of the item at store locations is old and well known in retail merchandising art.

It would have been obvious to one of ordinary skill in the art at the time of invention to scan the item at the store in order to verify the discount price of the item before making decision to purchase the item.

Conclusion

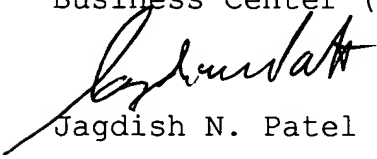
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

5/25/05